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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,090	03/31/2004	Le Huang		7338

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Hui Min He-Huang
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Northborough, MA 01532

EXAMINER

DAVIS, BRIAN J

ART UNIT PAPER NUMBER

1621

DATE MAILED: 03/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

DETAILED ACTION

Specification

Applicant has corrected the text of the specification so as to overcome the objection to the specification outlined in the previous Office Action. However, applicant's amendment raises a new objection, which follows.

The amendment filed 1/4/06 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the new paragraph applicant wishes to insert after the last paragraph on page 2 of the original. Applicant is required to cancel the new matter in the reply to this Office Action.

The examiner also notes that applicant has not correctly amended the specification with respect to the deletion of the word "novel" in either of the recently submitted amendments. Applicant is respectfully reminded that MPEP 714.22 (b) states that amendments to the specification, other than the claims, computer listings and sequence listings, must be made by adding, deleting or replacing a paragraph, by replacing a section, or by a substitute specification in the manner specified in this section. In order to advance prosecution, the examiner respectfully suggests that a new, substitute specification be submitted which has both the new matter and the word "novel" deleted (and which incorporates the chemical structure on page 1, *vide infra*). Such a specification will then be entered in the record.

Drawings

The drawings remain objected to for reasons of record.

The drawings were objected to in the previous Office Action because, although there should apparently be only one drawing, there are two of record in the application. (Figure 1 appeared to be legitimately a drawing and is described as such in the specification. Figure 2 appeared to be the missing diagram from page 1 of the specification.) Corrected drawing sheets, and or clarification, in compliance with 37 CFR 1.121(d) was required in reply to the Office action to avoid abandonment of the application. Applicant has since amended the specification such that the drawing of figure 2 appears in its proper place in the specification. The caption of Figure 1 was also amended, but not in accordance with the MPEP.

Applicant is respectfully reminded that any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If

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the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

112 Rejections Withdrawn

The rejection of claims 1-19 under 35 USC 112, second paragraph, outlined in the previous Office Action, has been overcome by applicant's amendment. With respect to claim 19, the amendment cancels the claim. With respect to claims 1 and 2, applicant's amendment and arguments have been carefully considered and are persuasive. The claims have been clarified as appropriate. With respect to the remaining claims, the rejection is now moot.

103 Rejections Withdrawn

The rejection of claims 7-16 and 19 under 35 USC 103(a), outlined in the previous Office Action, has been overcome. With respect to claim 19, applicant's amendment cancels the claim. With respect to the remaining claims, applicant's arguments have been carefully considered and are persuasive. The examiner is now in agreement with applicant that the cited references neither teach nor suggest applicant's method. At best, applicant's method might have been obvious to try, however, an 'obvious to try' standard is impermissible in two situations: 1) where the prior art gives no indication as to which of numerous parameters are critical, or gives no indication as to which of many possible choices is likely to be successful; and 2) where the prior art

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gives only general guidance with respect to the form of the invention but not how to achieve it new areas of technology or in fields of experimentation which are only seemingly promising. *In re O'Farrell*, 853 F2d 894, 7 USPQ 2d 1673, 1681 (Fed. Cir. 1988). In the instant case, 1) above applies.

103 Rejections Maintained

The rejection of claims 1-6, 17 and 18 under 35 USC 103(a), outlined in the previous Office Action, is maintained for reasons of record. Applicant's arguments have been carefully considered but are not persuasive.

In order for an invention to be obvious, two things must be found in the prior art: 1) the suggestion of the invention, and 2) the expectation of its success. *In re Vaeck*, 947 F2d 488, 492, 20 USPQ2d 1438, 1441 (Fed. Cir. 1991). In the instant case, the compound and its compositions (claims 1-4, 17 and 18) are obvious for the reasons set forth in detail in the previous Office Action. Both the suggestion of the invention and the expectation of its success are taught in general by the prior art. With respect to the method claims (claims 5 and 6), these general procedures are also obvious, again, for the reasons set forth in detail in the previous Office Action. Both the suggestion of the invention and the expectation of its success are taught in general by the cited prior art.

Allowable Subject Matter

Claims 7-16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian J. Davis whose telephone number is 571-272-0638. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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BRIAN DAVIS
PRIMARY EXAMINER

Brian J. Davis
March 14, 2006